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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,664	01/23/2002	Rudolf Zink	HP/5-21844/A/PCT/DIV	9293

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EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 09/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/055,664	ZINK ET AL.
	Examiner Andrea D Small	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 July 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) parts of 12 and claim 13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 12 is/are rejected.
- 7) Claim(s) 12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/806,349.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***I. Preliminary Matters:***

- (a) Applicants claim for priority under 35 USC 120 as a DIV of 09/806,349, now US Patent 6,358,496 which is a 371 of PCT/EP99/06984, which claims priority to EP 98810993 is acknowledged.
- (b) Preliminary amendment filed 1/23/2003 has been received and entered as paper no 3. Said amendment inserted the claim of priority into the first line of the specification.
- (b) Preliminary amendment to the claims filed 1/23/2003 has also been received and entered as paper no. 4.

-Claims 1-11 are cancelled.

-Claim 12 is amended and claim 13 is newly added.

- (c) Claims 12 and 13 are pending.

***II. Restriction/Election:***

Applicants response to restriction requirement of office action dated 7/1/2003 has been received and entered as paper no. 5. The Applicants have elected to prosecute the invention of Group I, claim 12 with traverse. The Applicants have also elected the compound (101) from example 1, page 12 of the specification for initial examination.

Traversal: Applicant asserts that upon the finding of the elected species to be allowable, the election requirement should be withdrawn and consideration of the patentability of the entire Markush group is solicited. MPEP 803.02. Additionally, upon the finding of the entire Markush group of claim 12 to be allowed, Applicant requests the rejoinder of claim 13 under *In re Ochiai*.

Art Unit: 1626

Response: The examiner agrees with both of Applicant's assertions, but in view of neither the elected species being found allowable, nor the entire claim 12 being found allowable, such a solicitation for extending the examination to the entire Markush group of claim 12 and the rejoinder of claim 13 with claim 12 is premature and the restriction and election requirement is proper and made FINAL.

*a SK* The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable of the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final. MPE 803.02

The elected species of compound (101) on page 12 is anticipated, see rejection below, therefore, the remainder of claim 12, that is not drawn to this elected species is withdrawn from consideration as being drawn to non-elected inventions. MPEP 803.02 and 37 CFR 1.142(b).

Claim 13 is also withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

***III. Rejections:***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by (a)Kuhltau (US 3,925,015, cited by Applicants).

Applicants elected species relate to compound as follows:



(a) Said species, which falls within the Markush-type claim 12 and is anticipated by Kuhtau, et al. See species 1,3,3-trimethyl-2-methylene-2,3-dihydroindol-w-aldehyde on col. 11 and 12, table at the bottom of the page, the first compound disclosed under section labeled 'aldehyde'.

The compound falls within the Markus-type claim of claim 12 where R1 is Hydrogen, R2 is

methyl, R3 is methyl, R4 is hydrogen and R5 is formula 1(b)  $\text{--}\overset{\text{H}}{\underset{\text{C}=\text{O}}{\text{o}}}\text{--}$ .

### ***III. Objections:***

Claim 12 is objected to for containing non-elected subject matter. 37 CFR 1.142(b).

### ***IV. Contact Information:***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small whose telephone number is (703) 305-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:30-6:30 PM. The number for accessing the facsimile machine is (703) 746-4984.

*Admire*  
\_\_\_\_\_  
Andrea D. Smale, Esq.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

August 27, 2003